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EXAMINER	
WINTER, JOHN M	

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The time period for reply, if any, is set in the attached communication.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte THOMAS J. COLSON, JOHN E.CRONIN, SAMUEL C. BAXTER, and ROBERT CANTRELL

Appeal 2008-004539
Application 09/931,492
Technology Center 3600

Decided:[1] June 30, 2009

Before MURRIEL E. CRAWFORD, HUBERT C. LORIN, and ANTON W. FETTING, *Administrative Patent Judges*.

CRAWFORD, *Administrative Patent Judge*.

DECISION ON APPEAL

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[1] The two-month time period for filing an appeal or commencing a civil action, as recited in 37 C.F.R. § 1.304, begins to run from the decided date shown on this page of the decision. The time period does not run from the Mail Date (paper delivery) or Notification Date (electronic delivery).

STATEMENT OF THE CASE

Appellants appeal under 35 U.S.C. § 134 (2002) from a Final Rejection of claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44.[2] We have jurisdiction under 35 U.S.C. § 6(b) (2002).

Appellants invented systems and methods for publishing product information by placing documents describing the product and commercial availability thereof in a searchable database via the Global Information Network (Internet) (Spec. 1:9-12).

Claim 11, reproduced below, is further illustrative of the claimed subject matter:

> 11. A method of publishing a product document, said method comprising the steps of:
>
> providing a searchable document database and a publication Web site in communication with said document database, where said database is publicly accessible;
>
> electronically receiving a product document transmitted by a client's computer, where said product document provides information regarding a commercially available product;
>
> publishing said product document by adding said product document to said document database, wherein said publishing is for the purpose of disclosing information about a product to

[2] Claims 17, 18, 39, and 40 are pending and objected to as being dependent upon a rejected based claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims and complying with double patenting statutes.

establish a bar to patentability of inventions practiced in said product; and,

digitally notarizing said product document and obtaining a document notarization record, said document notarization record including a timestamp and a digital fingerprint.

The prior art relied upon by the Examiner in rejecting the claims on appeal is:

Donner	US 6,154,725	Nov. 28, 2000
Rivette et al.	US 6,339,767 B1	Jan. 15, 2002
Khan et al.	US 6,401,206 B1	Jun. 4, 2002

The Examiner rejected claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44 under 35 U.S.C. § 103(a) as being unpatentable over Rivette in view of Donner and Khan.

OPINION

We have carefully reviewed the rejections on appeal in light of the arguments of the Appellants and the Examiner. As a result of this review, we have reached the conclusion that the applied prior art does not establish the prima facie obviousness of the claimed subject matter. Therefore the rejections on appeal are reversed. Our reasons follow.

The following comprise our finding of facts with respect to the scope and content of the prior art. Rivette discloses system 302 including web clients 304 communicating with databases 316 (Fig. 3) via web server 310 and enterprise server 314. Donner discloses an intellectual property audit system where a user inputs data into input device 14 of the system, and then database access device 16 of the system collects various data from different

on-line intellectual property databases 18 related to the data inputted into input device 14 (Fig. 2; col. 4, l. 66 through col. 5, l. 58).

The disagreement between the Appellants and the Examiner is whether a combination of Rivette and Donner renders obvious "a searchable document database and a publication Web site in communication with said document database, where said database is publicly accessible," as recited in independent claim 11 (App. Br. 8-10, 12-16; Ex. Ans. 4-5, 10-11; Reply Br. 5-9). The Examiner found that Rivette does not explicitly disclose that the database is publicly accessible. The Examiner then asserts, however, that Donner discloses that the database is publicly accessible (Ex. Ans. 4-5).[3]

Donner discloses a system that *collects* data from on-line intellectual property databases that may be publicly accessible; however, Donner does not disclose that the system *itself* and therefore the database within that system is publicly accessible. Thus, the Examiner has erred in presenting a prima facie case. The Examiner's rationale for combining Rivette and Donner, to form an IP portfolio utilizing material in the public domain, also makes it clear that it is the system of Donner, which is not shown to be publicly accessible, and not the source on-line intellectual property databases that are entered into Donner's system, being combined with databases 316 of Rivette (Ex. Ans. 4-5).

Even assuming *arguendo* that databases 316 of Rivette were modified to collect IP from the public domain, as set forth in the rationale for

[3] We note that the Response to Argument's section of the Examiner's Answer does not directly address this argument, other than a passing reference on page 11 that "the Appellants arguments appear to be directed towards whether the database is publically accessible, which is a feature disclosed by the Donner reference."

combining Rivette and Donner, the resulting combination is not that databases 316 are publicly accessible. Accordingly, because the Examiner has not established a prima facie case that a combination of Rivette and Donner renders obvious "where said database is publicly accessible," we do not sustain the rejection of independent claim 11. *See In re Oetiker*, 977 F.2d 1443, 1445 (Fed. Cir. 1992) (during examination, the Examiner bears the initial burden of establishing a prima facie case of obviousness).

By virtue of their dependence on independent claim 11, we also do not sustain the rejection of claims 2-10, 13-16, 19-22 and 24-32.

Independent claim 33 recites "a searchable document database, where said database is publicly accessible." For the same reasons we do not sustain the rejection of independent claim 11, we also do not sustain the rejection of independent claim 33. By virtue of their dependence on independent claim 33, we also do not sustain the rejection of claims 35-38 and 41-44.

CONCLUSION

The Appellants have shown that the Examiner erred in rejecting claims 2-11, 13-16, 19-22, 24-33, 35-38, and 41-44.

REVERSED

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